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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/697,428	10/26/2000	Bruce A Beadle	AUS9200000120US1	4820

7590 03/06/2006

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EXAMINER

THOMPSON, MARC D

ART UNIT	PAPER NUMBER
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2144

DATE MAILED: 03/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/697,428	Applicant(s) BEADLE, BRUCE A	
	Examiner Marc D. Thompson	Art Unit 2144	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/1/2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-5, 10-13 and 18-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-5, 10-13 and 18-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/25/2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This application has been examined.
2. The amendment, received 12/1/2005, has been entered into record.
3. Claims 2-5, 10-13, and 18-21 remain pending.

Priority

4. No claim for priority has been made in this application.
5. The effective filing date for the subject matter defined in the pending claims in this application is 10/26/2000.

Drawings

6. The Examiner contends that the drawings submitted on 10/25/2000 are acceptable for examination proceedings.

Double Patenting

7. No double patenting rejections are deemed appropriate at this time. Should Applicant be aware of any pending or issued patent applications containing directly relevant claimed subject matter, it is suggested this be disclosed to the Examiner seasonably.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claim 18-21 are rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the

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invention. Alternatively, claims 18-21 are rejected under 35 U.S.C. §112, first paragraph, as based on a disclosure which is not enabling.

10. The specification fails to disclose what a “computer readable medium” constitutes, and so, without proper metes and bounds on the limitation, implementation is not reasonably possible by one skilled in the art. Further, a physical storage medium (i.e., “computer usable medium”, as disclosed) critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). It will be presumed that the claims read “computer usable medium” as disclosed in the specification (Paragraph [0048]) to avoid issues regarding new matter.

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 2-3, 10-11, and 18-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

13. Claim 3 recites “responsive to one of the set of discovering at least one keyword within the page and automatically generating said group of keywords” in Lines 10-11 of the claim.

Claims 11 and 19 recite identical limitations. There is a lack of antecedent basis for “discovering at least one keyword within the page”, as claimed. No positive recitation of “discovering” is provided, and there is no description of what this function may involve or entail.

14. Claims 18-21 recite “computer readable medium” in the preamble of the claims. Since there is no positive description or definition of what this computer readable medium actually is,

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the use of this limitation is vague and indefinite. Further, even presuming parallel (or broader) description with the described “computer usable medium” in Paragraph [0048] of the specification, there is no indication of what type(s) of medium(s) this limitation is attempting to describe.

15. Clarification is required.

Claim Rejections - 35 USC § 101

16. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

17. Claims 18-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

18. Claims 18-21 recite “A computer-readable medium storing thereon a computer program product for...” in the first lines of the claim. It is noted that “computer-readable medium” is not expressly defined in the specification, leading to the following issues in regard to 35 USC 112, second paragraph, *Supra*. Further, given the intended interpretation provided above where the medium is considered a “computer-usable medium” as defined in the specification, this definition fails to limit the subject matter to tangible items, including transmission mediums which are not currently held to be statutory subject matter. See, inter alia, MPEP §2106, and 1300 Official Gazette Patent Office 142 (November 22, 2005) “Patent Subject Matter Eligibility Guidelines).

Claim Rejections - 35 USC § 102

19. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

20. Claims 4, 12, and 20 are rejected under 35 U.S.C. §102(e) as being anticipated by Bates et al. (U.S. Patent Number 6,832,350), hereinafter referred to as Bates '350.

21. Bates '350 disclosed organization and effective categorization of bookmarks (i.e., hotlist of pages) using keywords in the document and associated description(s). See, inter alia, Abstract. All the functionality was described as preferably implemented in a browser client application. See, inter alia, Column 7, Lines 33-39, and Column 9, Lines 18-20 and 31-41. The system determined "affinity" between bookmarked documents based on keywords from the document. See, inter alia, Column 2, Lines 65 through Column 3, Line 20. The system described both the use of HTML metadata tag information (inter alia, Column 3, Lines 20-23) and without use of metadata (inter alia, Column 3, Lines 29-31, and Column 11, Lines 31-34). The addition of a bookmark to the list by a user was evident, inter alia, in Column 9, Lines 42-44. The subsequent processing to create an entry representing the page (and associated affinity/other information) directly followed. The keyword information was stored in association with the bookmark entr(ies). Further provision for user editing of the entries was evident, inter alia, in Column 13, Lines 47-55.

22. Since the entirety of the invention as claimed was disclosed by Bates '350, claims 4, 12, and 20 are rejected.

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23. Claims 4, 12, and 20 are rejected under 35 U.S.C. §102(e) as being clearly anticipated by Douglass et al. (U.S. Patent Application Publication Number US 2002/0040311), hereinafter referred to as Douglass.

24. Douglass disclosed the automatic extraction of keywords/metadata from visited/bookmarked webpages, and user modification of these descriptive keyword(s). See, inter alia, Figure 1, and Page 2, Paragraphs [0020] through [0028]. Clearly, keyword fields were defined to designate particular keywords for the page(s) in the "Keyword Library" and storage of relevancy ratings. See, inter alia, step (26) and (40). The automatic generation of keywords for document(s) was disclosed as performed, inter alia, in step (30). Since, Douglass disclosed the processing of navigation history (not user designated) and/or bookmarks (necessarily user designated) to effect keyword generation and ratings for webpages in Paragraph [0024] and Figure 6, the provision for keyword generation to documents specified by the user to be of interest was clearly disclosed.

25. Claims 4, 12, and 20 are rejected.

Claim Rejections - 35 USC § 103

26. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

27. Claims 5, 13, and 21 are rejected under 35 U.S.C. §103(a) as being unpatentable over Bates et al. (U.S. Patent Number 6,832,350), hereinafter referred to as Bates '350, in view of

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what would have been obvious to one of ordinary skill in the art at the time the invention was made.

28. Bates '350 disclosed organization and effective categorization of bookmarks (i.e., hotlist of pages) using keywords in the document and associated description(s). See, inter alia, Abstract. All the functionality was described as preferably implemented in a browser client application. See, inter alia, Column 7, Lines 33-39, and Column 9, Lines 18-20 and 31-41. The system determined "affinity" between bookmarked documents based on keywords from the document. See, inter alia, Column 2, Lines 65 through Column 3, Line 20. The system described both the use of HTML metadata tag information (inter alia, Column 3, Lines 20-23) and without use of metadata (inter alia, Column 3, Lines 29-31, and Column 11, Lines 31-34). The addition of a bookmark to the list by a user was evident, inter alia, in Column 9, Lines 42-44. The subsequent processing to create an entry representing the page (and associated affinity/other information) directly followed. The keyword information was stored in association with the bookmark entr(ies). Further provision for user editing of the entries was evident, inter alia, in Column 13, Lines 47-55.

29. While Bates '350 disclosed the invention substantially as claimed, Bates '350 did not expressly disclose the provision for a user to select "automatic updating of the keyword field", as claimed. However, since editing of the keyword field(s) was expressly provided, and the automation of a manual activity is considered obvious to one skilled in the art (See, inter alia, MPEP §2144.04(III)) for the purpose of eliminating the need for a user to update all entries on a "hotlist" with new keyword data.

30. Claims 5, 13, and 21 are rejected.

31. Claims 5, 13, and 21 are rejected under 35 U.S.C. §103(a) as being unpatentable over Douglass (U.S. Patent Application Publication Number US 2002/0040311) as applied above, in view of what would have been obvious to one of ordinary skill in the art at the time the invention was made.

32. Douglass disclosed the automatic extraction of keywords/metadata from visited/bookmarked webpages, and user modification of these descriptive keyword(s). See, inter alia, Figure 1, and Page 2, Paragraphs [0020] through [0028]. Clearly, keyword fields were defined to designate particular keywords for the page(s) in the "Keyword Library" and storage of relevancy ratings. See, inter alia, step (26) and (40). The automatic generation of keywords for document(s) was disclosed as performed, inter alia, in step (30). Since, Douglass disclosed the processing of navigation history (not user designated) and/or bookmarks (necessarily user designated) to effect keyword generation and ratings for webpages in Paragraph [0024] and Figure 6, the provision for keyword generation to documents specified by the user to be of interest was clearly disclosed.

33. While Douglass disclosed the invention substantially as claimed, Douglass did not expressly disclose the provision for a user to select "automatic updating of the keyword field", as claimed. However, since editing of the keyword field(s) was expressly provided, and the automation of a manual activity is considered obvious to one skilled in the art (See, inter alia, MPEP §2144.04(III)) for the purpose of eliminating the need for a user to update all entries on a set of bookmarks with new, updated keyword data for each individual bookmark.

34. Claims 5, 13, and 21 are rejected.

Allowable Subject Matter

35. The provision for a browser client which performs user designation of pages of interest with subsequent entry creation, and in response to this designation and entry creation of a page of interest automatically generating a group of keywords based on the content of the page responsive to discovering an absence of keywords within metadata for the page, in combination with the storage of determined keywords in a keyword field of the particular entry in a hotlist of pages, is not reasonably taught or suggested in the prior art of record. This feature is persuasively argued by Applicant in the response filed 12/1/2005, inter alia, at Pages 9-14.

Response to Arguments

36. Applicant argues the prior art of record did not disclose “automatically generating a group of keywords based on the content of the page responsive to discovering an absence of keywords within metadata for the page”. See, the entirety of response, received 12/1/2005. Applicant further asserts “the arguments made with respect to claim 3 also apply to claims [], 4, and 5, which depend from and patentably distinguish exemplary claim 3” in Page 14, Section B of the response, received 12/1/2005. It is noted that claims 4 and 5 are independent claims which do not recite the argued features (automatically generating a group of keywords based on the content of the page responsive to discovering an absence of keywords within metadata for the page). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

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37. Claims 4, 5, 12, 13, 20, and 21, do not share this functional behavior with claims 2-3, 10-11, and 18-19, and as such, cannot be grouped together with these claims in regard to patentability.

38. Examiner notes that claims 4, 5, 12, 13, 20, and 21, essentially recites three common, distinct limitations:

I. Add page to hotlist (i.e., specify page if interest/bookmark)

II. Determine keywords from page

III. Store hotlist entry (i.e., bookmark)

Claims 4, 12, and 20, recite: IV. Allow user to edit keywords in entry

Claims 5, 13, and 21, recite: V. Allow user to select auto-updating of keywords

39. It is noted that there are potentially many, many more prior art citations which disclose the common limitations (i.e., I-III), since the claims do not preclude the usage of well known user-specified classification keywords and document embedded metadata usage. The provision for steps IV and V are likewise widely disclosed in the prior art, since the typical purpose of these types of systems are to provide customized categorization for particular users. Any potential reading of the claims which remains solely dependent upon these known methodologies should be avoided to advance prosecution.

Conclusion

40. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

41. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc D. Thompson whose telephone number is 571-272-3932.

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The examiner can normally be reached on Monday-Friday, 9am-4pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn, Jr., can be reached at 571-272-3922. The fax phone number for the organization where this application or proceeding is assigned has recently changed, and is now 571-273-8300.

42. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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